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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,830	05/14/2002	Jean-Marc Angeli	ANGELI=2	1390

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/889,830

Applicant(s)

ANGELI ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07232001.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

4. The examiner is unclear as to the bounds defined in claim 1. The applicant requires at least 10% by weight of a hydrophobic compound. The applicant then defines the KB value to be greater than or equal to 30 or less than 10% of a N-alkyl pyrrolidone. It is unclear to the examiner which solvents are required and specifically what is contained in the Markush group. It is suggested that the applicant more clearly define the hydrophobic active agent.

5. The examiner will read the claims as requiring one or more of the hydrophobic agent or the N-alkyl pyrrolidone. The examiner will further interpret the claims as requiring greater than or equal to 30 weight percent of the hydrophobic solvent or alternatively requiring less than 10% of the alkyl pyrrolidone.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. The examiner is unclear as to the compound defined by applicant as "propylene n-propyl ether." The examiner believes and will construe this term to mean "propylene glycol n-propyl ether" as this is the term used by applicant in the specification.

8. Finally, it should be noted that the translation provided appears to have numerous possible errors. It is suggested that the applicant further review the specification and correct these potential problems. For example, the applicant makes numerous references to terms enclosed in brackets (i.e. '<<' '>>'). It is unclear why these terms are bracketed (see page 4). Also, it is unclear why certain registered trademarks are not capitalized. For example on page 4 the applicant defines the term "mexoryl" and indicates trademark but does not capitalize the term. Other trademarks lack indication of their trademark.

9. The examiner is also confused by the two preliminary amendments filed 7/23/01. In one set of the claims, claim 2 is amended. In the second set, claim 3 is not amended.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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11. Claims 1, 2, 5, and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin et al (US 5,939,371).
12. Martin teaches a composition containing 18% d-limonene and 30% dipropylene glycol monomethyl ether (see abstract).
13. Claims 1-3, 5, and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Yokoi (JP408218027A).
14. Yokoi teaches a composition containing 40-80% propylene glycol monomethyl ether, 7-25% dipropylene glycol monomethyl ether, and a terpene resin.
15. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidhaeusler (JP408020736).
16. Schmidhaeusler teaches a composition containing 0.01-25% N-methyl pyrrolidone, 0.1-75% propylene glycol alcohol ether, 0.1-75% dipropylene glycol alcohol ether, 0.1-40% orange terpenes. Schmidhaeusler generally teaches the use of the methyl and propyl forms of the glycol ethers.
17. Claims 1-4, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Good (US 5,877,133).
18. Good teaches compositions containing alkyl esters of fatty acids (hydrophobic agent), a nonionic surfactant and a coupling agent (see claim 1).
19. Good further teaches the composition to be homogeneous and clear (see claims 2-3).  
Noting that a combination of soluble and insoluble components which form a clear solution do so because the insoluble component forms micelles smaller than the frequency of visible light

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(i.e. a microemulsion). There is no other physical manner that the composition of claim 1 would be clear and homogeneous unless a microemulsion was formed.

20. Good further teaches that the monohydric alcohol of claim 1 is a terpene alcohol (see claim 7).

21. Good teaches the addition of common coupling agents including dipropylene glycol n-butyl ether and terpene alcohols (see col. 4, lines 17-41) in amounts ranging from 2:1 to 1:2 of the ester to coupling agent (see claim 9).

22. Claims 1-4, and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Klier et al (US 5,811,383).

23. Klier teaches in table 5 a composition containing 25.8% d-limonene and 17.2% propylene glycol n-butyl ether. In table 8, Klier teaches a composition containing two glycol ethers (propylene glycol n-butyl ether and propylene glycol n-propyl ether) and heptane, a hydrophobic active agent with a KB value of 37. Klier further teaches these compositions to be microemulsions (see abstract). Klier generally teaches the use of high KB solvents including aliphatic esters, aliphatic hydrocarbons, paraffin solvents, chlorinated aliphatic hydrocarbons, etc. (see col. 4, lines 4-52).

24. Concerning claim 7, Klier generally teaches the use of glycol ethers in amounts ranging from 5-50%. Concerning claim 8, Klier generally teaches various dilutions (see col. 8, lines 1-15 and col. 2, lines 38-43).

***Allowable Subject Matter***

25. Microemulsions are well known. The use of glycol ethers in microemulsions are also well known as glycol ethers are well known coupling agents reducing micelle size and increasing

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the stability of the microemulsions. It is also well known to use terpenes in microemulsion cleaners as terpenes are well known natural cleaning agents with a pleasant smell.

26. Although no claims have been found allowable, it is suggested that the applicant more specifically define the hydrophobic agent, glycol ethers and weight percentages of these compounds. For example the specific combination of glycol ethers found in claim 6 in combination with the weight percentages of claim 7 and a specific Markush defining suitable hydrophobic agents could potentially be allowable.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb  
Primary Examiner  
Art Unit 1751